



ATTORNEY DOCKET NO. 01915/13921US03

IN THE UNITED STATES  
PATENT AND TRADEMARK OFFICE

In the Application of:

Carter, *et al.*

Serial No.: 09/924,110

Filed: August 7, 2001

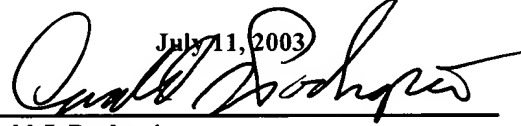
For: " MATERIALS AND METHODS FOR  
IMPROVED BONE TENDON BONE  
TRANSPLANTATION "

Group Art Unit: 3738

Examiner: Alvin J. Stewart

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450 on this date:

July 11, 2003  
  
Donald J. Pochopien  
Registration No. 32,167  
Attorney for Applicants

ELECTION OF INVENTION UNDER 35 U.S.C. § 1.121

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA, 22313-1450

Sir:

In response to the Official Communication of 05/16/03 ("Official Communication"), for which a response was due 06/16/03, now extended one (1) month to 07/16/03, the Applicants respond to the restriction requirement imposed by the Patent Office by making an election of an invention.

In the Official Communication, the Patent Office says that there are multiple inventions being claimed and that the Applicants are required to claim one of them for examination. The Patent Office has divided the claims into the following three groups of inventions:

- I. Claims 1-11, 27, and 28, directed to a bone tendon graft; and
- II. Claims 12-26, 29, and 30, directed to a method of making the grafts.

In addition, the Patent Office has further required an election of the following list of species:

# 17  
Election  
J. Boyce  
7/22/03

- I. Figure 2A;
- II. Figures 2B-4; and
- III. Figure 8.

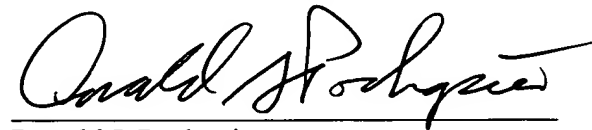
The Applicants elect, with traverse, to prosecute the claims of Group I, Species II, drawn to claims 1-11, 27, and 28 and directed to a bone tendon graft as depicted in Figures 2A-4.

The Applicants traverse the Examiner's assertion that the present claims are directed to patentably distinct species. Additionally, the Applicants traverse the Examiner's assertion that no generic claims have been found. Applicants respectfully assert that claim 1, as presently recited, generically encompasses Species I-III. Furthermore, Applicants respectfully state that a search and examination of Groups I and II would not represent a serious burden on the Examiner. See MPEP § 803. ("There are two criteria for a proper requirement for restriction between patentably distinct inventions: the invention must be independent or distinct as claimed; and there must be a serious burden on the Examiner if a restriction is required.") Therefore, restriction between Groups I and II, and the requirement for election between Species I-III is improper. Applicants respectfully request rejoinder of Group I and II and examination of Groups I and II on the merits.

Respectfully submitted,

**McANDREWS, HELD & MALLOY, LTD.**

By:



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Attorney for Applicants  
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34th Floor  
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(312) 775-8133

Date: July 11, 2003

J:\open\Djp\Regeneration Technologies\USPTO\13921US03\13921US03 Election



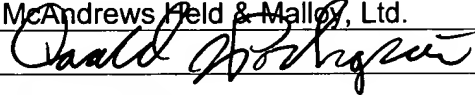

3738/8

PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM		Application Number	
(to be used for all correspondence after initial filing)		09/924,110	
		Filing Date	
		August 7, 2001	
		First Named Inventor	
		Carter, et al.	
Group Art Unit		3738	
Examiner Name		Alvin J. Stewart	
Attorney Docket Number		01915/13921US03	
Total Number of Pages in This Submission		5	
ENCLOSURES (check all that apply)			
<div><div><input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53</div><div><input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD Number of CD(s) _____</div><div><input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): - Election of Invention under 35 U.S.C. § 1.121</div></div>			
Remarks		RECEIVED JUL 21 2003 TECHNOLOGY CENTER R3700	
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm or Individual Name		McAndrews Held & Malloy, Ltd.	
Signature		 Reg. No. 32,167	
Date		July 11, 2003	
CERTIFICATE OF MAILING			
"Express Mail" mailing label number _____			
Date of Deposit: _____			
Name (Print/type)		Donald J. Pochopien	
Signature			
Registration No. (Attorney/Agent)		32,167	
Date		July 11, 2003	



PTO/SB/17 (11-00)

Approved for use through 10/31/2002. OMB 0651-0032  
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## FEE TRANSMITTAL for FY 2003

Patent Fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT (\$110.00)

**Complete if Known**

Application Number	09/924,110
Filing Date	August 7, 2001
First Named Inventor	Carter, et al.
Examiner Name	Alvin J. Stewart
Group Art Unit	3738
Attorney Docket No.	01915/13921US03

**METHOD OF PAYMENT**

1. ☐ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit  
Account  
Number  
Deposit  
Account  
Name

13-0017

McAndrews Held &amp; Malloy

- ☒ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17  
☐ Applicant claims small entity status.  
See 37 CFR 1.27

2. ☒ Payment Enclosed:

☒ Check ☐ Credit Card ☐ Money Order ☐ Other

**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1001	750	2001	375	Utility filing Fee	
1002	330	2002	165	Design filing Fee	
1003	520	2003	260	Plant filing fee	
1004	750	2004	375	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$)

**2. EXTRA CLAIM FEES**

	Extra Claims	Fee from below	Fee Paid
Total Claims	<input type="text"/> - 20** = <input type="text"/> x <input type="text"/> = <input type="text"/>		
Independent Claims	<input type="text"/> - 3** = <input type="text"/> x <input type="text"/> = <input type="text"/>		
Multiple Dependent	<input type="text"/> = <input type="text"/>		

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	84	2201	42	Independent claims in excess of 3
1203	280	2203	140	Multiple dependent claim, if not paid
1204	84	2204	42	**Reissue independent claims over original patent
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

Fee Code	Large Entity Fee (\$)	Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	110.00
1252	410	2252	205	Extension for reply within second month	
1253	930	2253	465	Extension for reply within third month	
1254	1,450	2254	725	Extension for reply within fourth month	
1255	1,970	2255	985	Extension for reply within fifth month	
1401	320	2401	160	Notice of Appeal	
1402	320	2402	160	Filing a brief in support of an appeal	
1403	280	2403	140	Request for oral hearing	
1451	1,510	1451	1510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,300	2453	650	Petition to revive - unintentional	
1501	1,300	2501	650	Utility issue fee (or reissue)	
1502	470	2502	235	Design issue fee	
1503	610	2503	315	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	750	2809	375	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	750	2810	375	For each additional invention to be examined (37 CFR 1.129(b))	
1801	750	2801	375	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify) _____					

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$110.00)

**SUBMITTED BY**

Complete (if applicable)

Name (Print/Type)	Donald J. Pochoplen	Registration No. (Attorney or Agent)	32,167	Telephone	(312) 775-8133
Signature		Date	July 11, 2003		

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